

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

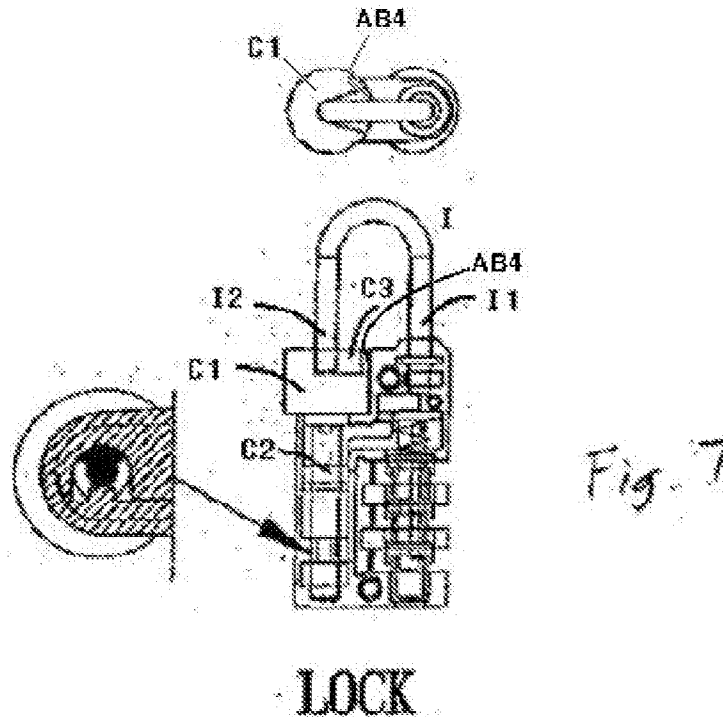
1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claim 42 is added to recite the padlock where the wall of the housing is substantially parallel with the root section of the shackle and is concaved toward the root section to form an outwardly facing concave surface. It is respectfully submitted that no new matter is added, since support for the claim may be found, for example, at least in paragraph [0011] of the accompanying description in the specification as originally filed.

Claim 43 is added to recite the padlock further having a locking mechanism disposed in the housing, where the locking mechanism is configured for control rotation. It is respectfully submitted that no new matter is added, since support for the claim may be found, for example, at least in paragraph [0013] of the accompanying description in the specification as originally filed.

Furthermore, it is respectfully submitted that claims 42 and 43 are supported by at least Fig. 7 of the provisional application 60/443,331 filed on January 29, 2003 (reproduced below).



For example, as shown in FIG. 7, the padlock of claim 42 further includes a wall (AB4) that is substantially parallel with the root section (I1) of the shackle and is concaved toward the root section, as depicted in the top view of the padlock in FIG. 7. The wall has an outwardly facing concave surface corresponding to a profile of an outer surface of the block portion (C1) of the confining block. In this way, the block portion can be partly guarded in the concaved wall to aid in the prevention of tamping with the block portion.

Moreover, the padlock of claim 43 further includes a locking mechanism, such as the numeral wheel set of FIG. 7, disposed in the housing. The locking mechanism is configured for control rotation of the confining block, as shown in FIGS. 7 and 8.

Claims 38-39 are left unchanged.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

2. Rejection of claim 38 under 35 U.S.C. § 103(a) as being unpatentable over CN2041340U (*Liu*)

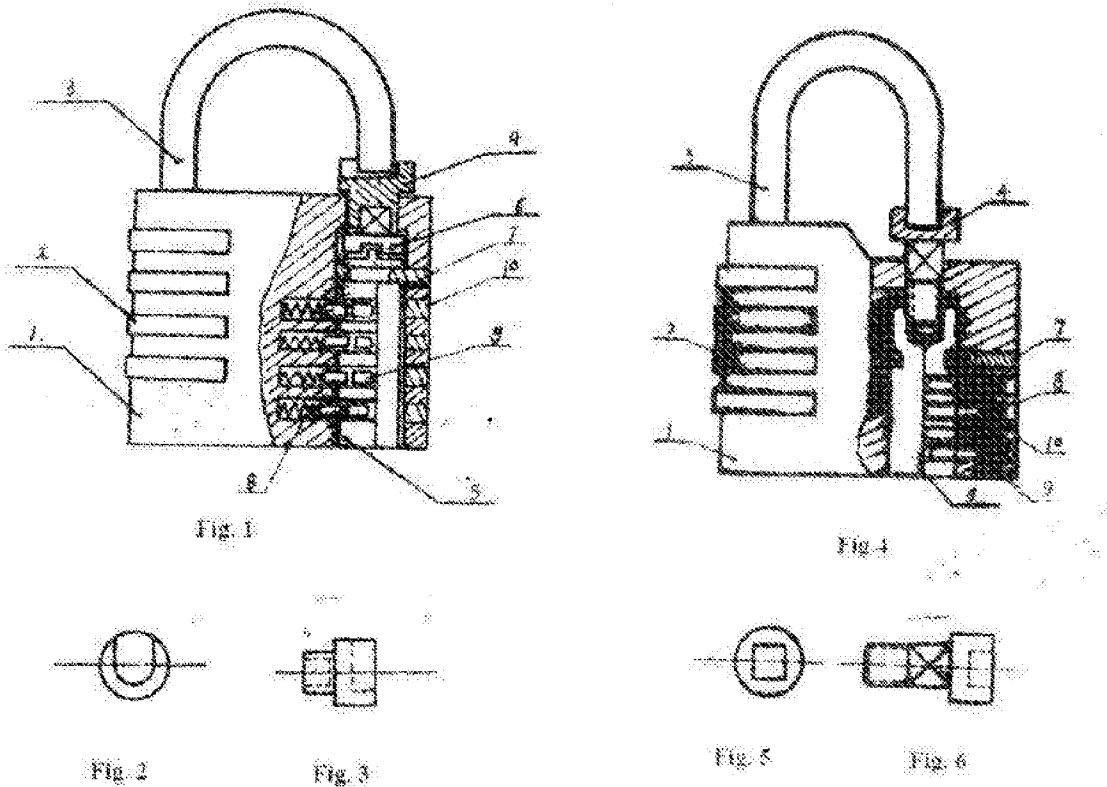
Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 38.

It is respectfully submitted that the Office Action has improperly combined the teachings disclosed in Figs. 1 and 4 of *Liu* for at least the following reasons.

Even assuming, but not admitting, that Fig. 1 of *Liu* discloses a padlock having a housing with a first and second hole facing in the same direction, a shackle having a root section received in the first hole of the housing and a first section extending outside of the housing, which is rotatable, and a confining block including a block portion, it is respectfully submitted that Fig. 1 of *Liu* fails to disclose a housing having a notch in the corner for receiving the block portion and a wall facing the notch as indicated in the Office Action dated October 14, 2010 on page 3. Although the Office Action on page 3 suggests that the combination of Figs. 1 and 4 of *Liu* teaches all of the features of claim 38, it is respectfully submitted that the Office Action has improperly combined the teachings.

As shown in Fig. 4 of *Liu*, reproduced below for clarity, the pin 4 (or the block portion) is machined with a square hole for reception of a square end of the shackle 3. To unlock the lock, a key is inserted into the lock cylinder 5 to cause the lock cylinder 5 to rotate, and the thread on the upper part of the lock cylinder 5 forces the pin 4 to move downwards and causes the square end of the shackle 3 to disengage from the square end of the pin 4 (*Liu*, pg. 6, Emb. 2). From this, the pin 4 of Fig. 4 is basically linearly movable with respect to the housing and includes only a top opening for the square hole. In contrast, the pin 4 of Fig. 1 is rotatable and includes a top opening and a side opening

for entrance or withdrawal of the shackle. In other words, the two pins 4 in Figs. 1 and 4 have different constructions.



As shown in Fig. 4, the wall facing the pin 4 is a slope and has nothing to do with aiding in the prevention of tampering, but simply provides a pleasant appearance for the lock. This is suggested from the wall being oblique and spaced apart from the pin 4, and the pin 4 of Fig. 4 defines only one opening in a top surface and therefore the sloping wall and the square hole of the pin 4 are still separated by the pin 4. Therefore, there is no teaching for the sloping wall to guard the square hole of the pin 4. In other words, even having the feature of a wall, *Liu* discloses the use of a different type of pin 4, in Figs. 1 and 4.

Therefore it is respectfully submitted that a modification of the lock of Fig. 1 with the features of Fig. 4 would require skill of one having ordinary skill in the art that is beyond the simple substitution of known elements to obtain a predictable results.

Instead, one having ordinary skill in the art would have to drastically change the configuration of the locks to combine such features. Since such a drastic change would require knowledge beyond the simple substitution of known elements, one having ordinary skill in the art would not have been led to combine such features. Additionally, no evidence has been suggested as to why one having ordinary skill could have or would have combined such elements as required by MPEP 2141.

Furthermore, it is respectfully submitted that the proposed combination of Figs. 1 and 4 of *Liu* fails to disclose or suggest the block portion being rotatable between a first position where the second opening faces the wall of the housing, and a second position where the second opening is turned away from the wall of the housing as recited in claim 38.

At most, *Liu* discloses a shackle that is fitted into a lock engaging portion on the housing. However, it is respectfully submitted that in neither Fig. 1 or Fig 4, is there any disclosure of a block portion together with a stem portion being rotatable with respect to the housing between a first position where the second opening faces the housing, and a second position where the second opening is turned away from the wall (Provisional App. 60/443,331, Figs. 5, 7 and 8).

Since the proposed combination of Figs. 1 and 4 of *Liu* fails to disclose each and every feature recited in claim 38 or in the alternative the figures are improperly combined, a *prima facie* case of obviousness has not been established.

Accordingly, withdrawal of this rejection is respectfully requested.

3. Rejection of claim 39 under 35 U.S.C. § 103(a) as being unpatentable over CN2041340U (*Liu*) in view of U.S. Pat. No. 6,035,672 (*Lai*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 39.

Specifically, *Lai* fails to cure the deficiencies of *Liu* as discussed above in detail with respect to claim 38, from which claim 39 depends. In other words, *Lai* additionally fails to disclose a block portion that is rotatable with respect to the housing between a first position where the second opening faces the wall, and a second position where the second opening is turned away from the housing as recited in claim 38.

Accordingly, withdrawal of this rejection is respectfully requested.

4. Rejection of claim 38 under 35 U.S.C. § 103(a) as being unpatentable over CN2041340U (*Liu*) in view of U.S. Pub. No. 20020088256 (*Taylor*) or the Columbia reference (*Columbia*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 38.

It is respectfully submitted that the proposed combination of *Liu*, *Taylor*, and *Columbia* at least fails to disclose a block portion having a receptacle, where the block portion is rotatable with respect to the housing between a first position where the second opening faces the wall of the housing, and a second position where the second opening is turned away from the wall of the housing as recited in claim 38.

As discussed above in detail, *Liu* fails to disclose a block portion having a receptacle that is rotatable, but only discloses the shackle that is detachably connected to the housing (Figs. 1 and 4).

Similar to the deficiencies of *Liu*, *Taylor* at most discloses a shackle that is detachably connected to the housing (Fig. 3; paragraph [0006]). The shackle is preferably a swivel only J-shaped shackle where it's free end is captured in a reciprocating collar (paragraph [0008]). Although the Office Action on page 4 suggests that the shackle sleeve 96 is the block portion as recited in claim 38, it is respectfully submitted that the shackle sleeve is not disclosed as being rotatable between a first position and a second position.

Instead, the shackle sleeve 96 is disclosed as being hollow and cylindrically-shaped (paragraph [0044]). The shackle sleeve is configured to move downward when the thumb latch 90 is moved (paragraph [0044]). It is respectfully submitted that a downward movement of a shackle sleeve does not disclose the same feature of a rotatable block portion between a first position and a second position as recited in claim 38.

Furthermore, it is respectfully submitted that *Columbia* is not prior art to the pending application. The pending application claims a priority to provisional application 60/443,331, filed on January 29, 2003.

Although, *Columbia* was published on November 2002, it is respectfully submitted that *Columbia* shares joint inventors with the pending application. In other words, inventors of *Columbia* with respect to the lock, which is “manufactured and distributed by Cerf Brothers Bag Company,” are also inventors of the ‘331 application. Notably as can be seen in Figs. 9-11 of the ‘331 application, the padlock shown in *Columbia* is of a similar appearance and has the same trademark “Columbia” as in Figs. 9-11 of the ‘331 application. Therefore; it is respectfully submitted that *Columbia* is not prior art to the pending application, since the present application was timely filed within one year of the publication of *Columbia*.

Accordingly, withdrawal of this rejection is respectfully requested.

5. Rejection of claim 39 under 35 U.S.C. § 103(a) as being unpatentable over CN2041340U (*Liu*) in view of U.S. Pub. No. 20020088256 (*Taylor*) or the Columbia reference (*Columbia*) and further in view of U.S. Pat. No. 6,035,672 (*Lai*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 39.

As discussed above in detail, *Lai* fails to cure the deficiencies of *Liu*, *Taylor*, and *Columbia*, since the proposed combination of *Liu*, *Taylor*, *Columbia*, and *Lai* still fails to

disclose each and every feature of claim 38, from which claim 39 depends.
Accordingly, withdrawal of this rejection is respectfully requested.

6. Rejection of claim 38 under 35 U.S.C. § 103(a) as being unpatentable over the Columbia reference (*Columbia*) in view of CN2041340U (*Liu*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 38.

As discussed above in detail, *Columbia* fails as a primary reference with respect to the pending application, since *Columbia* is not prior art since *Columbia* shares common inventors with the pending application.

Accordingly, withdrawal of this rejection is respectfully requested.

7. Rejection of claim 39 under 35 U.S.C. § 103(a) as being unpatentable over the Columbia reference (*Columbia*) in view of CN2041340U (*Liu*) and further in view of further in view of U.S. Pat. No. 6,035,672 (*Lai*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 39.

As discussed above in detail, *Columbia* is not prior art to the pending application. Therefore, since *Columbia* fails as a primary reference, this rejection is respectfully traversed as failing to disclose each and every feature of claim 38, from which claim 39 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

8. New Claims

Claims 42 and 43 are patentable over the cited prior art references, at least for their dependency on claim 38, as discussed above in detail, as well as their individually recited features.

9. Conclusion

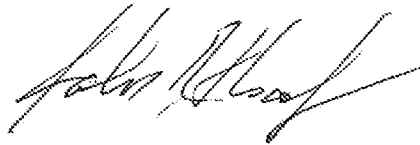
In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500
Facsimile: (703) 683-1080

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John R. Schaefer", written in a cursive style.

Date: January 14, 2011

JOHN R. SCHAEFER
Attorney for Applicants
Registration No. 47,921